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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,178	07/16/2003	Douglas S. Horne	8603.63	2354

21999 7590 11/20/2007  
KIRTON AND MCCONKIE  
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SALT LAKE CITY, UT 84111

EXAMINER
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HOEKSTRA, JEFFREY GERBEN

ART UNIT	PAPER NUMBER
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3736

MAIL DATE	DELIVERY MODE
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11/20/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/621,178	<b>Applicant(s)</b> HORNE ET AL.	
	<b>Examiner</b> Jeffrey G. Hoekstra	<b>Art Unit</b> 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 September 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 August 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/29/2007</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Notice of Amendment***

1. In response to the amendment filed on 09/13/2007, canceled claim(s) 1-6 and 15 is/are acknowledged. The current rejections of the claim(s) 7-14 is/are *withdrawn*. The following new and reiterated grounds of rejection are set forth:

### ***Election/Restrictions***

2. Applicant's election without traverse of Species B, embodiment drawn to claims 7-14 and comprising a method of obtaining electrical signals from a dermal area of a patient's skin using inter alia a detector and a stationary element, in the reply filed on 09/13/2007 is acknowledged.

3. Claims 1-6 and 15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 09/13/2007.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Information Disclosure Statement***

5. The information disclosure statement(s) (IDS) submitted on 05/29/2007 is/are acknowledged. The submission is in compliance with the provisions of 37 CFR 1.97

and 1.98. Accordingly, the examiner is considering the information disclosure statement(s).

### ***Drawings***

6. The drawings, filed 08/27/2006, are objected to because Figures 6-12 contain graphs with unlabeled axes. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

7. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is

requested in correcting any errors of which applicant may become aware in the specification.

***Claim Objections***

8. Claims 7 and 11 are objected to because of the following informalities: the positive recitation of "said biasing element" in line 6 appears to lack antecedent basis and may render the claim indefinite. The Examiner notes Applicant may have intended to positively recite "a biasing element". Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 7-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Kenan et al. (US 6,788,966 B2, hereinafter Kenan).

11. For claims 7 and 11, Kenan discloses a method for obtaining an electrical signal from a patient at the patient's skin, said method comprising:

- locating a dermal area (712) of said patient approximating a meridian;
- contacting, with a probe (102) (as best seen in Figures 2 and 7), said dermal area (700), said probe comprising:

- a stationary element (110) to stabilize said probe against said dermal area (column 3 lines 1-45, column 5 lines 31-57, and column 13 lines 51-59);
  - a probe tip (112) operably connected to a biasing element (622) to apply a pressure to said dermal area (column 3 lines 1-45, column 5 lines 31-57, and column 14 lines 20-46);
  - a detector (28) operably connected to said probe tip to detect an electrical signal at the patient's skin corresponding to said pressure;
  - a feedback loop (24) connected to said detector to provide a feedback signal containing information with respect to said electrical signal at the patient's skin (column 3 lines 1-45, and column 5 lines 31-57); and
  - the biasing element connected to said feedback loop to receive said feedback signal (column 3 lines 1-45, column 5 lines 31-57, and column 14 line 65 – column 15 line 4) and adjust said pressure in accordance with said feedback signal (column 3 lines 1-45, column 5 lines 31-57, and column 15 lines 36-48);
- obtaining, from said probe, an electrical signal (704) (column 10 lines 23-38) at the patient's skin corresponding to said meridian (column 7 lines 27-41 and column 8 lines 50-64); and
  - measuring relative conductance (706,708,710,850) of a dermal area of said patient proximate a meridian (column 7 lines 27-41 and column 8 lines 50-64).

12. For claim 8, Kenan discloses a method for obtaining an electrical signal from a patient at the patient's skin, wherein said locating a dermal area further comprises

providing a point locator (852,854) for indicating a dermal location having a substantially greater bioelectric conductance value than a surrounding dermal area (column 7 lines 27-41 and column 8 lines 50-64), said point locator configured to produce audible signals indicating said location (column 21 lines 11-25).

13. For claims 9 and 13 Kenan discloses a method for obtaining an electrical signal from a patient at the patient's skin, wherein said probe further comprises: a conductive base (151); and an abrasive bristly matrix (108) coupled to a surface area of said conductive base, wherein a plurality of bristles (the tips of bristly matrix 108) of said abrasive bristly matrix simultaneously contact said dermal area (column 2 lines 47-60, column 14 lines 47-64).

14. For claims 10 and 14, Kenan discloses a method for obtaining an electrical signal from a patient at the patient's skin, wherein said information comprises a bioelectric conductance value (column 7 lines 27-41 and column 8 lines 50-64).

15. For claim 12, Kenan discloses a method for obtaining an electrical signal from a patient at the patient's skin, wherein said measuring relative conductance of a dermal area further comprises: iteratively measuring a bioelectric conductance value of a surface of said dermal area (column 7 lines 27-41, column 8 lines 50-64, and column 19 lines 47-63); iteratively comparing a first said bioelectric conductance value corresponding (852) to a first surface location to a second said bioelectric conductance value (854) corresponding to a second surface location; audibly indicating a dermal location where said second bioelectric conductance value is substantially greater than

said first bioelectric conductance value (column 7 lines 27-41 and column 8 lines 50-64).

***Response to Arguments***

16. Applicant's arguments, filed 05/29/2007, with respect to claims 7-14 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey G. Hoekstra whose telephone number is (571) 272-7232. The examiner can normally be reached on Monday through Friday 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 3736

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J.H./  
Jeff Hoekstra  
Examiner, Art Unit 3736

*McH...*  
MANAGEMENT  
EXAMINER  
CENTER 3736